

RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3738

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PATENT

Attorney Docket No. 101.0092-02000
Customer No. 22882

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Confirmation No.: 6591
Gary Karlin Michelson)
Serial No.: 10/669,287) Group Art Unit: 3738
Filed: September 24, 2003) Examiner: Thomas Barrett
For: EXPANDABLE PUSH-IN ARCUATE)
INTERBODY SPINAL FUSION IMPLANT)
WITH TAPERED CONFIGURATION)
DURING INSERTION)

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY TO FINAL OFFICE ACTION

In reply to the Final Office Action of March 17, 2005, the period for reply having been extended for three months by a Petition for Extension of Time and fee filed herewith, and pursuant to 37 C.F.R. § 1.116, the following remarks are submitted:

In the Office Action, the Examiner provisionally rejected claims 1-9, 13, 33, 54-92, and 94-96 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9, 11, 13-20, and 24-55 of Applicant's Application No. 10/669,291, now U.S. Patent No. 6,793,679 (the "679 patent"). Applicant is submitting concurrently with this Amendment a Terminal Disclaimer of the terminal part of any patent granted in the present application which would extend beyond the expiration of the '679 patent.

The Examiner rejected claims 1-72, 74-76, and 84-87 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,117,174 to Nolan ("Nolan"). Applicant respectfully traverses the Examiner's rejection. Independent claim 1 recites a push-in spinal fusion implant having upper and lower members "having a first position relative to

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one another allowing for a collapsed implant height during insertion of said implant into the spine and a second position relative to one another allowing for an increased height, said arcuate portions of said upper and lower members in the first position being angled to one another over a substantial portion of the length of said implant."

Nolan teaches a spinal implant that is substantially cylindrically-shaped when inserted between two adjacent vertebrae. (See Nolan, col. 2, lines 60-61). According to the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' [citation omitted]." (MPEP § 2131 (May 2004)). The only insertion position taught by Nolan is one in which the implant is cylindrical-shaped. No other insertion position is taught by Nolan. Accordingly, Applicant submits that independent claim 1 is novel over the disclosure of Nolan.

Moreover, independent claim 1 recites the "push-in implant" including "at least a portion of a bone-engaging projection is adapted for linear insertion." Nolan teaches an embodiment in which "an outer surface 94 of the body 92 is threaded." (Nolan, col. 7, lines 14-15; Fig. 18). Applicant respectfully traverses the Examiner's contention that "[t]he threads act as bone-engaging projections that allow for linear insertion." (Office Action, page 4, paragraph 3). Threads require an element of rotation and are not adapted for linear insertion. Indeed, Nolan distinguishes the difference in how a threaded implant is inserted as opposed to an implant without threads by teaching that a threaded implant "will further require threading the body 92 into the disc receiving areas as opposed to press fitting into place." (Nolan, col. 7, lines 20-22).

The Examiner contends that "[c]ol. 4 lines 21-23 discloses that widths 26 and 28 in figure 3 can be of different sizes, therefore the shape may be frusto-conical." (Office Action, page 4, paragraph 3). Even, *assuming arguendo*, the shape of the Nolan implant could be frusto-conical, as noted above, Nolan does not teach or suggest a bone-engaging projection adapted for linear insertion. According to the MPEP, "[e]ven if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference." (MPEP § 2116.01 (May 2004)).

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Accordingly, Applicant submits that the rejection of claims 1-72, 74-76, and 84-87 under 35 U.S.C. § 102(e) as being anticipated by Nolan has been overcome.

The Examiner rejected claims 73 and 88 under 35 U.S.C. § 103(a) as being unpatentable over Nolan in view of U.S. Patent No. 4,961,740 to Ray et al.; and rejected claims 77-83 and 89-96 under 35 U.S.C. § 103(a) as being unpatentable over Nolan. Applicant submits that the rejections over claims 73, 77-83, and 88-96 are rendered moot at least because they depend from an allowable independent claim, or claims dependent therefrom.

Applicant submits that independent claim 1 is patentable and that dependent claims 2-96 dependent from independent claim 1, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

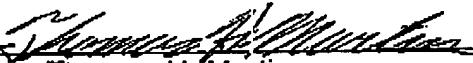
In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: September 19, 2005

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